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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	310048-355	4296

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/158,728	Applicant(s) WEIRATHER ET AL.	
	Examiner Alicia Chevalier	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 429,432-458,460,461,463-468 and 471-478 is/are pending in the application.
- 4a) Of the above claim(s) 436 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 429,432-435,437-458,460,461,463-468 and 471-478 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 429, 432-458, 460, 461, 463-468 and 471-478 are pending in the application, claim 436 is withdrawn from consideration. Claims 430, 431, 459, 462, and 469-470 have been cancelled.
2. Amendments to claim 459, filed on July 20, 2004, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §112 rejections of claim 459, made of record in paper #46, mailed January 15, 2004, pages 2-3, paragraph#6 have been withdrawn due to Applicant's cancellation of the claim in the response filed July 20, 2004.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

5. Claims 429, 432-435, 437-451, 453-461, 474, 475, 477 and 478 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross (U.S. Patent No. 4,863,772) in view of Popat et al. (U.S. Patent No. 5,407,718).

Regarding Applicant's claims 429 and 478, Cross discloses a label stock with a dry separation interface, used as tags, coupons identification cards and the like (*col. 1, lines 7-9*). The label stock comprises a facestock proper, which reads on Applicant's claimed "cardstock sheet," an adhesive, which reads on Applicant's claimed adhesive layer, and polyethylene layer, which reads on Applicant's claimed "film layer," which constitutes a dry facestock construction, which reads on Applicant's claimed "facestock sheet construction" (*col. 5, lines 13-16 and figure 5*). From figure 5 it can be seen that the dry facestock construction has a front side and a back side and that the adhesive is on a backside of the facestock proper and the polyethylene layer is on the adhesive layer. The label stock further comprises a web that acts as a release liner (*col. 5, lines 8-9 and figure 5*). From figure 5 it can be seen that portions of the back side of the facestock construction forming back side surfaces of the label, Applicant's "business card." The label stock is provided in a roll stock and can be supplied to a label manufacturer who prints and die-cuts individual labels (*col. 7, lines 1-2*).

The preamble "a printable business card sheet" is deemed to be a statement of intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP 2111.02.

The limitation "the liner sheet is extrusion coated on one side with the film layer" in claim 478 is a process limitation. The process of forming the product is not germane to the issue of patentability of the product itself. The determination of patentability for a product claim containing a process limitation is based on the product itself and not on the process of

production. The prior art discloses a product which reasonably appears to be either identical to or only slightly different from Applicant's product claim containing the process limitation. The burden is on Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product structurally differs in kind from that of the prior art.

Cross fails to disclose the claimed facestock continuous through-cut lines configurations with matrix waste portion etc.

Popat teaches label sheets used for printing with personal computers (*col. 1, lines 12-19*). The label sheets comprise a sheet construction that comprises a label layer and an adhesive layer, and backing layer (*col. 2, lines 64-68*), which acts as a release liner (*col. 3, lines 18-19*).

The sheet construction comprises die cut lines that extend through the label layer and through the adhesive layer, but do not pierce the backing layer. The backing layer remains intact as the labels are removed one by one, allowing the labels to be conveniently stored on the full sheet when only a few labels are left (*col. 3, lines 15-21*). Popat's die cut lines therefore, read on Applicant's claimed "facestock continuous through-cut lines through the facestock sheet construction to the back side but not through the liner sheet." Since Popat's backing layer is not die cut and is left as a full sheet it reads on Applicant's "a continuous liner sheet releasably secured to and covering the back side."

Popat further discloses that die cuts form the numerous labels (*col. 2, lines 64-66*) and additional die cuts are provided to form flexible edges (*col. 3, lines 1-2*), which reads on Applicant's limitation "the through-cut lines defining at least in part perimeter edges of printable business cards and a matrix waste portion."

Since the backing layer remains intact as the labels are removed one by one (*col. 3, lines 15-21*), the areas of the sheet covers the back sides of all the die cut lines and thereby constructed and adapted to hold the label, Applicant's "business card," and the flexible edges, Applicant's "matrix waste portion," together if the label sheet is fed through a printer or copier for a printing operation on the labels. Further, the phrase "adapted to hold the business cards when the printable business card sheet is fed through a printer or copier for a printing operation on the printable business cards" is a functional limitation. In the absence of convincing objective evidence, this adaptation is deemed a latent property. MPEP 2145(II).

Since additional die cuts are provided to form flexible edges (*col. 3, lines 1-2*), which separate the edge portions from the labels and the backing layer remains intact as the labels are removed one by one, allowing the labels to be conveniently stored on the full sheet when only a few labels are left (*col. 3, lines 15-21*), the backing layer and the die cut lines are constructed and adapted to allow the labels to be removed from the backing layer and the flexible edges and separated after a printing operation into individual labels.

Cross and Popat are analogous because they are both discussing labels.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use sheet construction, i.e. a single sheet with the label layer with die cuts and a continuous release liner, with the die cut lines of Popat as the sheet construction of Cross in order to make Cross' label stock usable with personal computer printers and, thereby make the labels accessible to the home consumer.

One of ordinary skill in the art would have been motivated to make Cross' labels usable for personal computer printers by Popat's teachings (*col. 1, lines 12-19*). It is desirable to make the labels accessible to the home consumer to increase marketability and profits.

For convenience, the table below shows Applicant's structural limitations with the corresponding prior art structure feature.

<i>Applicant</i>	<i>Cross</i>	<i>Popat</i>
Facestock sheet construction	facestock construction	label layer
Card Stock	facestock proper	
Adhesive layer	adhesive	
Film layer	polyethylene layer	
Liner sheet	web	Backing layer
Printable business card	label	Label
Facestock continuous through-cut lines		die cuts
Matrix waste portion		flexible edges

Regarding Applicant's claims 432-433 and 447, Popat discloses backing layer remains intact, i.e. it is solid (*col. 3, lines 15-21*) and shows in figures 2 and 3 that the backing sheet covers all of the back sides of all the die cut lines and extends the entire width and back side of the label layer.

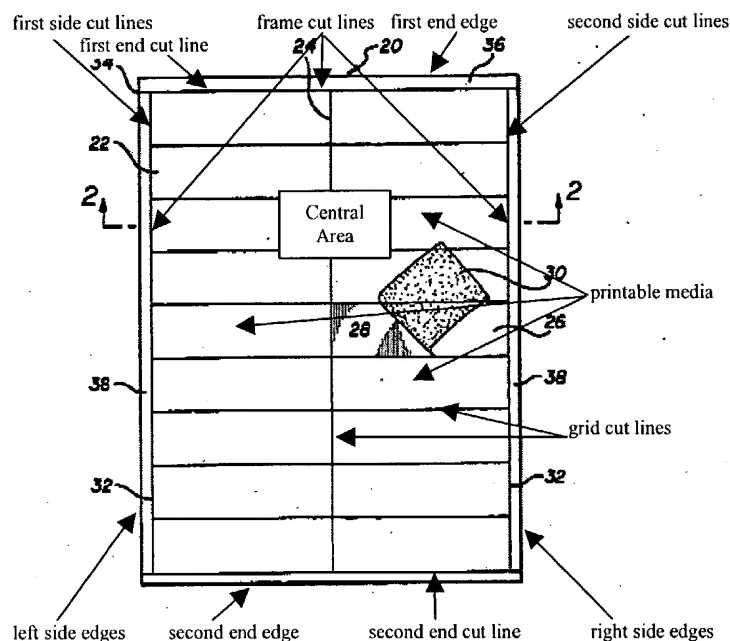
Regarding Applicant's claims 434-435, in figure 1 of Popat it can be seen that adjacent labels directly abut one another and share common edges and are arranged in a matrix on the label layer.

Regarding Applicant's claim 437, figure 1 in Popat shows that the label layer includes left and right side edges, the die cut lines include frame cut lined and grid cut line, the frame cut lines include first and second side cut lines spaced in from the left and right side edges respectively, and disposed parallel thereto, and first and second end cut lines engaging both of the side cut lines, the frame cut lines defining a central area on the label layer, the grid cut lines

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defining a grid disposed in the central area, and the grid cut lines and the frame cut lines separating the central area into printable media.

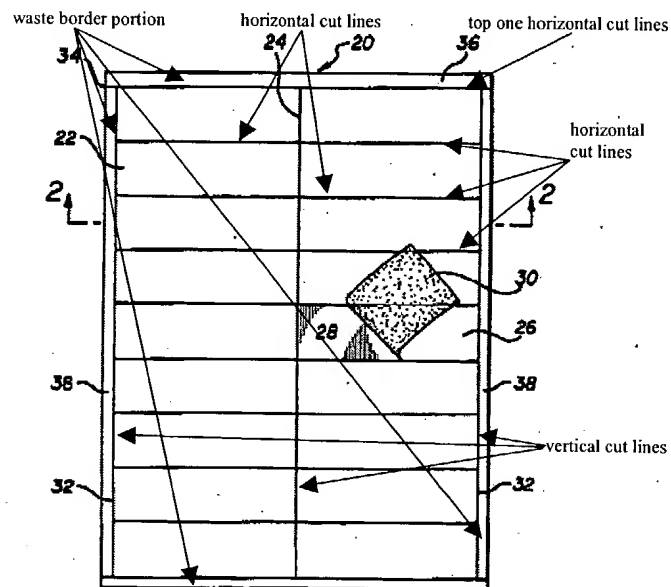
The following figure from Popat accompanies the discussion of claim 437.



Regarding Applicant's claims 438 and 444-446, Cross discloses that the liner proper is a base paper sheet such as densified bleached kraft sheet (*col. 5, lines 32-34*). The liner proper is 3.1 mil thick (*col. 5, line 32*), which reads on Applicant's claimed thickness of *approximately 3.0 mil and 2.0 mil*.

Regarding Applicant's claims 439-443, figure 1 in Popat shows that at least some of the die cut lines define a waste border portion of the label layer around the label, the die cut lines include vertical and horizontal cut lines. The top one of the horizontal cut lines extends a full width of the label layer and the ends of the rest of the horizontal cut lines are spaced inwardly from the left and right side edges of the label layer.

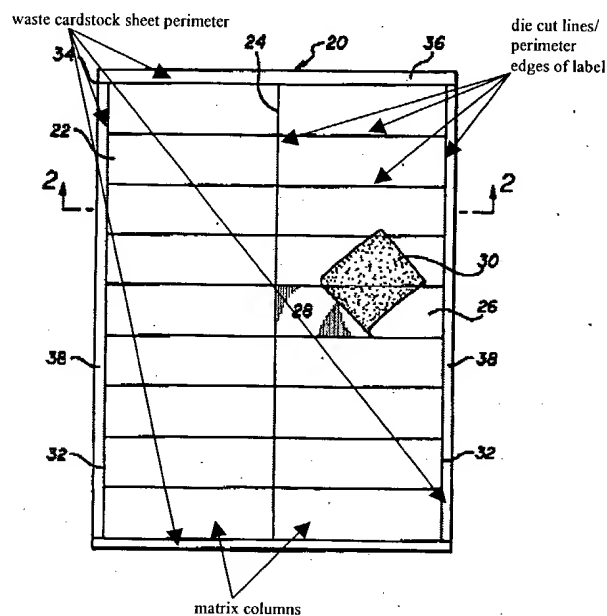
The following figure from Popat accompanies the discussion of claim 439-443.



Regarding Applicant's claims 448-451 and 459, Popat shows in figure 1 that the die cut lines define all of the perimeter edges of all the labels and the labels are arranged in a two column matrix or a pair of butt-cut columns. Figure 1 further shows that the labels in each column of the two-column matrix abut adjacent labels in the same column separated only by respective ones of the die cut lines. The matrix block of labels is surrounded by a waste cardstock sheet perimeter.

The following figure from Popat accompanies the discussion of claim 448-451 and 459.

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Regarding Applicant's claims 453-458 and 460, Cross discloses the claimed invention except for the adhesive being a hot melt adhesive or the film layer being polyester.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a hot melt adhesive for the adhesive or polyester for the dry release film layer, since it would have been within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, unless hot melts and polyesters give unexpected results. *In re Leshin*, 125 USPQ 416.

Furthermore, the exact thickness of the layers is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would require routine experimentation to determine the optimum value of a result effective variable, such as combined thickness of layers, in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir.

1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used.

Regarding Applicant's claim 461, Popat shows in figures 1-3 that the label layer and the backing layer are both rectangular and have the same width and length dimensions.

Regarding Applicant's claims 474 and 475, Cross shows in figure 5 that the web is secured directly to the back side of the facestock construction and a back side of the web defines a back surface of the label. Furthermore, figure 5 shows that the top surface of the facestock proper is the top surface of the label.

Regarding Applicant's claim 477, Cross discloses a polyethylene layer (*col. 5, lines 13-16 and figure 5*), which reads on Applicant's claimed "film layer."

6. Claims 452 and 476 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross (U.S. Patent No. 4,863,772) in view of Popat et al. (U.S. Patent No. 5,407,718) as applied to claims 429, 432-435, 437-451, 453-461, 474, 475, 477 and 478 above, and further in view of Carlson (U.S. Patent No. 5,842,722).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the facestock proper, Applicant's cardstock sheet, is a top-coated facestock proper.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (*col. 1, lines 16-18*). The printable laminate includes die cut cards, which are coated with an ink receptive coating (*col. 19, line 50 through col. 20, line 3*). The ink receptive coating provides good ink image retention and adhesive retention (*col. 20, lines 1-3*).

Cross, Popat and Carlson are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the facestock suggested by the combination of Cross and Popat in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (*col. 20, lines 1-3*). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

7. Claims 463 and 464 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross (U.S. Patent No. 4,863,772) in view of Popat et al. (U.S. Patent No. 5,407,718) as applied to claims 429, 432-435, 437-451, 453-461, 474, 475, 477 and 478 above, and further in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the an edge of the sheet is thinner than a body of the sheet or that the sheet is calendered.

Examiner's comment: The limitation "the lead-in edge of the printable business card sheet is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the lead-in edge of the printable business card sheet is

calendared," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Cross, Popat and Hickenbotham are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet suggested by the combination of Cross and Popat above, as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at *col. 1, lines 38-51*.

It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

8. Claims 465-468 and 471-473 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross (U.S. Patent No. 4,863,772) in view of Popat et al. (U.S. Patent No. 5,407,718) as applied to claims 429, 432-435, 437-451, 453-461, 474, 475, 477 and 478 above, and further in view of Klein (U.S. Patent No. 5,198,275).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the liner sheet includes a flexibility/cut line.

Klein discloses a card stock sheet for labels (*col. 3, line 13*) comprising a lift out panel with rectangular score cuts, an adhesive, and a backing sheet with perforations (*figure 6*). The backing sheet with perforations corresponds to Applicant's liner sheet with flexibility/cut lines. The perforations ensure a smooth peripheral edge of each panel and smoothness of the edge at the panel face is enhanced without any roughness or frying or torn paper (*col. 3, lines 62-66*).

Cross, Popat and Klein are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Klein's perforations to the web suggested by the combination of Popat and Cross in order to facilitate easy removal of the web. One of ordinary skill in the art would have been motivated to use Klein's perforations as taught in *col. 3, lines 62-66*, where Klein teaches that the perforations ensure a smooth peripheral edge without any roughness of frying or torn paper.

The exact distance of the liner sheet cut lines to the end of the sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments in the response filed July 20, 2004 regarding the 35 U.S.C. 103 rejections of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the limitation "printable business cards" is not taught by either Cross or Popat.

As pointed out in the office action, the preamble "printable business card sheet" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Applicant further argues that Popat is concerned with adhesive labels and not with business cards (non-adhesive).

Popat was the secondary reference not the primary reference and was relied upon for teaching continuous through-cut lines configurations with matrix waste portion. Furthermore, Applicant is attacking the references individually and in combination as they were applied. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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9/22/04




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1772

9/23/04